

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 8/27/2009, and has been entered and made of record. Currently, **claims 1, 3, 6, 7, 9, 12 – 16 and 19 – 21** are pending.

Response to Arguments

2. Applicant's arguments (*see Remarks 8/27/2009*) have been fully considered but they are not persuasive.
3. Regarding **claims 1, 6, 7, 12, 13, 19 and 20**, the Applicant argues that **Voticky et al.** (U.S. Patent No. 6,351,764).does not disclose, teach or suggest any determination that is made as to whether data received over a network is response data to the response request (*see Remarks 8/27/2009 [page 8]*).

However, Voticky does disclose any determination that is made as to whether data received over a network is response data to the response request. First, the prior art discloses reception of data over the network (*see Figs. 1 – 2 wherein the e-mail data includes identifiers [e.g. e-mail address, domain name, other characteristics of received messages, etc.] and wherein identifiers of the source of information expected to be received by client 8 from the network 2 are entered in step 14 [column 4, lines 14 – 17, column 5, lines 34 – 37 and column 6, lines 32 – 33]*). The data received via the network may be response data to the response request (*see Fig. 2 wherein incoming e-mail is a reply e-mail to a first sent e-mail [column 6, lines 36 – 40]*). Voticky then discloses determining whether the received data is a response data to the response

request (see Fig. 2 wherein method 10 prioritizes incoming e-mail messages based upon the identifiers such that expected incoming e-mail messages are ranked higher than those unexpected e-mail messages from unknown e-mail addresses [column 3, line 52 – column 4, line 6, column 4, lines 25 – 36, column 6, lines 32 – 45] especially when prioritization is based upon a “priority alphanumeric code” (PAC), one can assign the outgoing mail [i.e. response request] to “Reply PAC” such that when replied to by a user, this message [i.e. response data to reply request] would be directed to a particular mailbox based on how the PAC is designated as to priority [column 6, lines 53 – 58 and column 7, lines 30 – 35]). Furthermore, Voticky discloses ranking the identified response data higher than other data (see Fig. 2 wherein method 10 PAC-designated e-mails [i.e. response data to response request] are discriminated among non-PAC-designated e-mails [i.e. other data] [column 4, lines 51 – 54 and column 8, lines 35 – 39]).

Therefore, the Applicant’s arguments regarding claims 1, 6, 7, 12, 13 and 19 – 21 are considered not persuasive. Please cite rationale of the grounds of rejection below for further explanation.

4. Regarding **claims 1, 6, 7, 12, 13, 19 and 20**, the Applicant argues that **Eggleston et al.** (U.S. Patent No. 5,764,899) does not disclose, teach or suggest that the reply message constitutes response data to the response request from a receiving-end device and that comparing the size of the reply message to a predetermined data size (see *Remarks 8/27/2009 [page 9]*).

However, Eggleston does disclose that the reply message constitutes response data to the response request (*see Fig. 9 wherein a reply message to a preceding message is identified through comparison matching of extracted text in steps 918 – 930 [column 13, lines 31 – 46 and 53 – 55]*). In other words, the reply message constitutes a response to a response to the response request (i.e. preceding message) because, under the broadest reasonable interpretation as the claim would be interpreted by one of ordinary skill in the art, an e-mail reply (e.g. an e-mail message with "RE:" appearing in the subject header) is well-known in the art as a response to an original e-mail message. For example, it is well-known in the art that an e-mail message with "RE: Business Meeting" in the subject header is a reply to the original message titled "Business Meeting." In this instance, the e-mail reply message is in response to the original e-mail message, which is equivalent to a response request (*see Fig. 4 wherein a message may be created in response to a preceding message [column 7, line 59 – column 8, line 2]*). Eggleston teaches identifying such e-mail reply messages based upon the preceding original message(s) in a variety of ways, especially by evaluating the content of the subject header (*column 8, lines 26 – 27, column 10, lines 28 – 34 and column 13, lines 31 – 33*).

Also, the Applicant argues that the comparison matching of occurs between a replay message and a preceding message, both of which are sent by the same client. However, Eggleston discloses a response request from a receiving-end machine and a response to the response request from a communications device (*see Fig. 9 wherein replies [i.e. response to response request] being sent to the client [i.e. communications*

device] can similarly use an optimized reply to minimize message sizes [as a result of comparison matching] where a reply is received by the server [i.e. receiving-end machine or inherently a conduit of a receiving-end machine, such as another client] which has the client as an addressee [i.e. one to whom something is addressed] [column 13, lines 22 – 28]). Therefore, the Examiner respectfully disagrees with the Applicant that Eggleston teaches that the reply message and the preceding message are sent from the same client.

Furthermore, Eggleston does disclose comparing the size of the reply message to a predetermined data size in another embodiment (*see Fig. 5 wherein the message size is compared to a maximum size threshold as criteria for e-mail filtering in step 508 [column 8, lines 16 – 17, 23 – 24 and column 9, lines 62 – 67]*). The teachings within Eggleston are combinable and would have been obvious to one of ordinary skill in the art at the time of the invention for the reasons discussed below.

Therefore, the Applicant's arguments regarding claims 1, 6, 7, 12, 13 and 19 – 21 are considered not persuasive. Please cite rationale of the grounds of rejection below for further explanation.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 8/27/2009 was filed after the mailing date of the non-final Office Action on 5/27/2009. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

7. ***Claims 13, 14 and 19*** are rejected under 35 U.S.C. 102(b) as being anticipated by **Voticky *et al.*** (U.S. Patent No. 6,351,764).

Referring to **claim 13**, Voticky discloses a communications device (*see Fig. 1, client 8 [column 2, line 64 – column 3, line 9] transmitting/receiving data over a network (see Fig. 1, communications network 2 [column 3, lines 10 – 15 and 44 – 51]) and making a request for a response to a data transmission from a receiving-end machine, said device comprising:*

data identifying means for determining whether data to be received over the network is response data to the response request (see Fig. 2 wherein identifiers of the source of information expected to be received by client 8 are entered in step 14 [column 4, lines 14 – 36 and column 5, lines 34 – 37]), and

receipt control means for ranking, concerning receiving of data (see Fig. 2, step 20 [column 4, lines 51 – 54, column 6, lines 43 – 57 and column 7, lines 36 – 41]), data identified as the response data by the data identifying means higher than other data (column 6, lines 36 – 45, column 7, lines 30 – 35 and column 8, lines 35 – 39).

Referring to **claim 14**, Voticky discloses the device further wherein:

the communications device transmits/receives data through the network and a relay device (see Fig. 1, server 6 [column 3, lines 10 – 19]), the relay device receiving

and storing data addressed to the communications device over the network and for assigning identity information and a serial number to each of stored data sets, the stored data sets being renumbered where necessary so that they are serially numbered (*column 7, lines 11 – 18 wherein the PAC numbers, which are serially organized from A1100 through A1394 in this example, are assigned to and prioritize received messages*), and

when data is to be received from the relay device, the receipt control means changes a data receiving ranking by way of a request to the relay device from a ranking indicated by the serial numbers (*see Fig. 1 wherein server 6, which has the identical functionality of client 6, filters or discriminates for prioritizing e-mail messages [column 3, line 52 – column 4, line 6]*).

Referring to **claim 19**, the rationale provided above in rejection of claim 13 is incorporated herein. The apparatus of claim 13 performs the method steps stored as a program of instructions of claim 13 within memory and executed by one or more processors (*see Fig. 1, server 6, client 8 [column 2, line 64 – column 3, line 9 and column 3, line 61 – column 4, line 6]*).

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
9. **Claims 1, 6, 7, 12 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Eggleston et al.** (U.S. Patent No. 5,764,899).

Referring to **claim 7**, Eggleston discloses a communications device (*see Figs. 1 – 2 wherein mobile station (MS) 105, which may be one or more user devices such as wireless subscriber units, communicates with host processor 115 [column 4, lines 4 – 11]), comprising:*

transmission/receipt means for transmitting/receiving data over a network (*see Figs. 1 – 2, network 130 [column 2, lines 59 – 65 and column 4, lines 4 – 51]),*

response request embedding means for embedding a response request for a response to a data transmission from a receiving end machine in transmitted data (*see Fig. 9 wherein responses to earlier data transmissions [e.g. prior e-mails] are optimized for transmission [column 11, lines 37 – 47]),*

data identifying means for determining whether data to be received over the network is response data to the response request by comparison (*see Fig. 9 wherein a reply message to a preceding message is identified through comparison matching of extracted text in steps 918 – 930 [column 13, lines 31 – 46 and 53 – 55]), and*

receipt control means for controlling receipt so as to preferentially receive data identified as the response data by the data identifying means over other data (*see Fig. 9 wherein the message sizes of responses to earlier data transmissions [e.g. mail messages] are minimized if they exceed the threshold [i.e. generated delta] of an optimized reply [Abstract, column 3, lines 35 – 56, column 11, lines 37 – 47, column 9, line 61 – column 12, line 8]) but does not explicitly disclose the device further wherein the determination of response data by comparing a size of the data to be received to a predetermined data size.*

However, in another embodiment, Eggleston does disclose the device comparing a size of the received response data to a predetermined data size, such that the identified response data is received preferentially (*see Fig. 5 wherein the host server filters a response to a preceding client generated message based upon applied filters beginning in step 502 and then the message size of the response is compared to a maximum size threshold in step 508 such that messages exceeding the threshold are treated differently than messages meeting the criteria [e.g. reject] [column 7, line 59 – column 8, line 2, column 8, lines 16 – 33, 58 – 59 and column 9, lines 62 – 67]*).

The teachings within Eggleston are combinable because they are two separate embodiments yet from the same field of endeavor. At the time of the invention, it would have been obvious to one of ordinary skill in the art to substitute the comparison matching of text of response messages taught by Eggleston for the comparison matching of size of response messages taught by Eggleston without yielding an unexpected result. Since each individual element and its function are shown in the prior art, albeit shown in separate embodiments within the same reference, the difference between the claim and that of the prior art rests not on any individual element or function yet relies on the very combination itself, namely the substitution of text comparison for size comparison. Because both text comparison and size comparison are applied to response message data to determine preferred handling methods (e.g. message filtering), one of ordinary skill in the art would determine that this mere substitution of one element for another known in the field would yield predictable results. The suggestion/motivation for applying such a combination of reject/pass filter criteria

would have been to allow the user to determine preferred handling methods, especially when avoiding more expensive and time-consuming transmissions (i.e. transmissions related to available bandwidth and message sizes), as suggested by Eggleston (*column 1, lines 50 – 67 and column 8, lines 44 – 57*).

Referring to **claim 1**, the rationale provided in the rejection of claim 7 is incorporated herein. In addition, claim 7 embodies the limitations and elements of those in claim 1.

Referring to **claim 20**, the rationale provided in the rejection of claim 1 is incorporated herein. In addition, the apparatus of claim 1 performs the method of claim 20.

Referring to **claims 6 and 12**, the rationale provided above in rejections of claims 1 and 7, respectively, are incorporated herein. The apparatuses of claims 1 and 7 perform the methods steps stored as programs of instructions of claims 6 and 12, respectively, within memory and executed by one or more processors (*see Fig. 1, mobile station (MS) 105, host processor 115, communications server 110, CD-ROM 107 [column 4, lines 16 – 29]*).

10. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Voticky et al.** (U.S. Patent No. 6,351,764) in view of **Eggleston et al.** (U.S. Patent No. 5,764,899).

Referring to **claim 15**, Voticky discloses the device as discussed above in the rejection of claim 13 but does not explicitly disclose the device further wherein the data

identifying means determines whether data to be received is the response data by comparing a size of the data to be received to a predetermined data size.

Eggleston discloses a communications device (*see Figs. 1 – 2 wherein mobile station (MS) 105, which may be one or more user devices such as wireless subscriber units, communicates with host processor 115 [column 4, lines 4 – 11]*) transmitting/receiving data over a network (*see Figs. 1 – 2, network 130 [column 2, lines 59 – 65 and column 4, lines 4 – 51]*) and making a request for a response to a data transmission from a receiving end machine in transmitted data (*see Fig. 9 wherein responses to earlier data transmissions [e.g. prior e-mails] are optimized for transmission [column 11, lines 37 – 47]*), said device comprising:

data identifying means for determining whether data to be received over the network is response data to the response request by comparison (*see Fig. 9 wherein a reply message to a preceding message is identified through comparison matching of extracted text in steps 918 – 930 [column 13, lines 31 – 46 and 53 – 55]*), and

receipt control means for controlling receipt so as to preferentially receive data identified as the response data by the data identifying means over other data (*see Fig. 9 wherein the message sizes of responses to earlier data transmissions [e.g. mail messages] are minimized if they exceed the threshold [i.e. generated delta] of an optimized reply [Abstract, column 3, lines 35 – 56, column 9, lines 37 – 47, column 9, line 61 – column 12, line 8]*) but does not explicitly disclose the device further wherein the determination of response data by comparing a size of the data to be received to a predetermined data size.

However, in another embodiment, Eggleston does disclose the device comparing a size of the received response data to a predetermined data size, such that the identified response data is received preferentially (*see Fig. 5 wherein the host server filters a response to a preceding client generated message based upon applied filters beginning in step 502 and then the message size of the response is compared to a maximum size threshold in step 508 such that messages exceeding the threshold are treated differently than messages meeting the criteria [e.g. reject] [column 7, line 59 – column 8, line 2, column 8, lines 16 – 33, 58 – 59 and column 9, lines 62 – 67]*).

The teachings within Eggleston are combinable because they are two separate embodiments yet from the same field of endeavor. At the time of the invention, it would have been obvious to one of ordinary skill in the art to substitute the comparison matching of text of response messages taught by Eggleston for the comparison matching of size of response messages taught by Eggleston without yielding an unexpected result. Since each individual element and its function are shown in the prior art, albeit shown in separate embodiments within the same reference, the difference between the claim and that of the prior art rests not on any individual element or function yet relies on the very combination itself, namely the substitution of text comparison for size comparison. Because both text comparison and size comparison are applied to response message data to determine preferred handling methods (e.g. message filtering), one of ordinary skill in the art would determine that this mere substitution of one element for another known in the field would yield predictable results. The suggestion/motivation for applying such a combination of reject/pass filter criteria

would have been to allow the user to determine preferred handling methods, especially when avoiding more expensive and time-consuming transmissions (i.e. transmissions related to available bandwidth and message sizes), as suggested by Eggleston (*column 1, lines 50 – 67 and column 8, lines 44 – 57*).

Voticky and Eggleston are combinable because they are from the same field of endeavor, being e-mail organization systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include filtering e-mails in such messaging systems based upon bandwidth and message sizes. The suggestion/motivation for doing so would have been to determine preferred handling methods, especially when avoiding more expensive and time-consuming transmissions, as suggested by Eggleston (*column 1, lines 50 – 67 and column 8, lines 44 – 57*).

11. **Claims 3 and 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Eggleston et al.** (U.S. Patent No. 5,764,899) in view of **Haneda et al.** (U.S. Patent No. 6,189,027).

Referring to **claim 9**, Eggleston discloses the device as discussed above in the rejection of claim 7 but does not explicitly disclose the device further comprising storage means for storing received data, and storage control means for controlling storing to the storage means so that after storing the received data, the storage means is left with empty space needed to store the response data.

Haneda discloses the device comprising:

storage means (*see Fig. 1, storage section 6 [column 3, lines 37 – 48]*) for storing received data, and

storage control means (*see Fig. 1, host computer 1*) for controlling storing to the storage means so that after storing the received data, the storage means is left with empty space needed to store the response data (*column 1, lines 27 – 58, column 2, lines 5 – 15 and column 3, lines 15 – 33*).

Eggleston and Haneda are combinable because they are from the same field of endeavor, being e-mail systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include memory management along with such e-mail systems. The suggestion/motivation for doing so would have been to secure sufficient memory capacity for urgent or important e-mails while providing an easy, convenient memory management scheme for the user, as suggested by Haneda (*column 1, lines 43 – 58 and column 2, lines 12 – 15*).

Referring to **claim 3**, the rationale provided in the rejection of claim 9 is incorporated herein. In addition, claim 9 embodies the limitations and elements of those in claim 3.

12. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Voticky et al.** (U.S. Patent No. 6,351,764) in view of **Haneda et al.** (U.S. Patent No. 6,189,027).

Referring to **claim 16**, Voticky discloses the device as discussed above in the rejection of claim 7 but does not explicitly disclose the device further comprising storage means for storing received data, and storage control means for controlling storing to the

storage means so that after storing the received data, the storage means is left with empty space needed to store the response data.

Haneda discloses the device comprising:

storage means (*see Fig. 1, storage section 6 [column 3, lines 37 – 48]*) for storing received data, and

storage control means (*see Fig. 1, host computer 1*) for controlling storing to the storage means so that after storing the received data, the storage means is left with empty space needed to store the response data (*column 1, lines 27 – 58, column 2, lines 5 – 15 and column 3, lines 15 – 33*).

Voticky and Haneda are combinable because they are from the same field of endeavor, being e-mail systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include memory management along with such e-mail systems. The suggestion/motivation for doing so would have been to secure sufficient memory capacity for urgent or important e-mails while providing an easy, convenient memory management scheme for the user, as suggested by Haneda (*column 1, lines 43 – 58 and column 2, lines 12 – 15*).

Allowable Subject Matter

13. **Claim 21** is allowed.

Referring to **claim 21**, the innovative limitation that distinguishes the Applicant's claim is the unobvious combination of two disclosed embodiments: 1) the receipt control means changing the ranking by way of a request to the relay device from the ranking

indicated by the serial numbers (*see Fig. 4*), and 2) a storage control means controlling storing to storage means so that after storing the received data, the storage means is left with empty space needed to store the response data higher than the other data (*see Fig. 9*).

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myles D. Robinson whose telephone number is (571)272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on (571) 272-7406. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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12/14/09

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